

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have amended claims 3, 6 and 17 in order to clarify the subject matter of the invention and to overcome § 112 rejections. Support for the amendments to claims 6 and 17 may be found, for example, in Figs. 2 and 5 of the specification. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art.

II. The Rejection Of Claims 1, 3-6, 10-11 And 17-18 Under 35 U.S.C. § 112

Claims 1, 3-6, 10-11 and 17-18 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. Applicants respectfully traverse these rejections for at least the following reasons.

With regard to claims 1 and 3-5, it is alleged that the limitation “ the language of each language group of printed documents **consisting** of one of the plurality of languages” introduces new subject matter because the limitation is not specifically described in the original specification. In addition, the Examiner alleges that the above cited recitation lacks specificity because the applicants fail to point out the individual elements in the close ended limitation, so that the Examiner does not know how many elements in the group and what each element really is. Applicants submit that the limitation does not introduce new subject matter and is specific.

As is shown in Fig. 5 of the drawings, there are provided a set of printed documents each consisting of a plurality of languages (languages A, B and C). Page 11, lines 10-22 describe the

process of Fig. 5 in that the processing unit 102 performs a translation...such that each of the languages is translated into each language A, B and C. Then, the translated document data translated into each of the languages A, B and C are output by each language group. Thus, each language A, B or C is one of the plurality of language groups. Furthermore, it is well known to anyone skilled in the art what a plurality of languages consists of. To suggest that the specification does not enable one skilled in the art to practice the invention is improper. A listing of all possible languages known to man is not necessary to one skilled in the art to determine that the present invention is directed to the translating of one language into a plurality of other languages or a plurality of languages into one language. Thus, Applicant's respectfully submit that the enablement requirement is satisfied.

With regard to claims 6, 10, 11 and 17-18, it is alleged that the original specification does not specifically describe how to specify document data of **a document** including a plurality of different languages to be translated into a plurality of languages and outputted by language groups. It is unclear as to what the Examiner is referring to in this rejection. In the December 27, 2005 Office Action, the Examiner pointed out that "the limitation 'document data' is broad and can be interpreted in many ways, including a single or multiple documents...". Thus, the Examiner has admitted that the term "document data" can be interpreted to mean "document data of a document". As such, it is improper for the Examiner to state that the specification does not describe how to specify document data of a document, when he alleged that document data covers the range of "document data of a document". As such, Applicants respectfully submit that claim 6 does not add new subject matter. Furthermore, this limitation does not prevent one skilled in the art from making or using the invention. A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would

understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 USPQ 568, 574 (Fed. Cir. 1984). It should be noted also that the disclosure need not recite the claim language in *haec verba*. *In re Smith*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973). It is readily apparent to one skilled in the art, that the present invention is concerned with the translation of printed documents into other languages. One skilled in the art would readily understand the use and function of the present invention upon reading the specification and claims. Accordingly, Applicants respectfully request that the § 112 rejection be withdrawn.

III. The Rejection Of Claims 1, 3-14 and 16-18 Under U.S.C. § 103

Claims 6-9 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi et al. (USP No. 5,701,497) in view of Fujita (5,612,872); claims 1, 4-5, 10-14, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores et al. (USP No. 6,370,498); and claim 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi in view of Fujita and Flores, and further in view of Miyahara et al. (USP No. 6,314,213). Applicants respectfully traverse the rejections of the above cited pending claims for at least the following reasons.

With regard to the present invention, claim 1 recites, in-part, a translating apparatus, comprising: translating means for translating document data into another language; an output unit for outputting the translated document data translated by said translating means in printed form...to output the translated document data by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.

Similarly, claim 6 recites, in-part, a translating apparatus, comprising: translating means for translating document data of a document into another language; an output unit for outputting the translated document data translated by said translating means; ... to output the translated document data by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.

Furthermore, claim 11 recites, in-part, a translating apparatus wherein, said controller controls said translating means so as to translate each of the first document data and the second document data into a first language and a second language, and controls said output unit so as to output the first and second document data translated into the first language as a first group and the first and second document data translated into the second language as a second group, and claim 14 recites, in-part, wherein, said controller controls said translating means so as to translate the document data in an original language into a first language and a second language, each being different from the original language, and controls said output unit so as to output the document data translated into the first and second languages as a common group of printed documents.

Moreover, amended claim 17 recites, in-part, a translating apparatus wherein, when said input document data includes a first document data written in a first language and a second document data written in a second language, said controller controls said translating means so as to translate said input document data into at least one language, and controls said output unit so as to output the translated input document data by groups, each group of the translated document data comprising printed documents in the original languages and printed documents of the

translated document data translated into said at least one language with each of the printed documents being distinct from one another

Yamauchi and Fujita do not disclose or suggest translating a document and controlling the output unit so as to output the translated document data by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in each of the plurality of languages with *each of the printed documents being distinct from one another*, as recited in independent claims 1 and 6. Nor do the references suggest any separation or separate grouping of the translated documents from the original documents to make them distinct as disclosed in claims 11, 14 and 17 of the present invention. In contrast, both Yamauchi and Fujita display the original language text and the translated text side-by-side on the same printed document (see, for example, Fig. 24 of Yamauchi and Fig. 2 of Fujita). Thus, the printed document of the original language document or documents and the translated document or documents in the cited prior art are not distinct from one another. As such, Yamauchi and Fujita fail to render claims 1, 6, 11, 14 and 17 obvious. Nor does Flores or Miyahara remedy this deficiency.

As is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As Yamauchi, Fujita, Flores, or Miyahara all fail to disclose the above cited limitations, then based on the foregoing, it is submitted that Yamauchi, alone or in combination with Fujita, Flores, or Miyahara does not render claims 1, 6, 11, 14, 17, or any claim dependent thereon obvious.

IV. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1, 6, 11, 14 and 17 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

V. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Date: December 12, 2006